

REMARKS

Claims 1, 2, 4-6, 8-20 are all the claims pending in the application. The Examiner withdrew the rejections as set forth in the previous Office Action. However, the Examiner found a new basis for rejecting claims 1, 2, 4-6, 8-20 under § 103. Reconsideration and allowance of claims 1, 2, 4-6, 8-20 are respectfully requested in view of the following remarks.

I. Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 4-6, and 8-20, under §103(a) as being unpatentable over US Patent 4,296,069 to Smith et al. (hereinafter Smith) in view of US Patent 5,811,306 to Komatsu (hereinafter Komatsu) and US Patent 5,059,393 to Quenin et al. (hereinafter Quenin). Applicant respectfully traverses this rejection by arguments as set forth below.

A. Independent Claims 1, 9 and 16

First, with respect to independent claims 1, 9 and 16, there is no motivation for combining Smith, Komatsu and Quenin.

“[O]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination” In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) (citing ACS Hosp. Sys. v. Montefiore Hosp., 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Winner International Royalty Corporation v. Ching-Rong Wang, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000). Conclusory statements such as common knowledge to

one skilled in the art or common sense do not fulfill the agency's obligation. In re Sang Su Lee, 277 F.3d 1338, 1345 - 46, 61 U.S.P.Q.2d 1430, 1438 (2002).

In the present case, one of ordinary skill in the art would not have been motivated to combine Smith and Komatsu as suggested by the Examiner. Smith teaches an apparatus for processing an analysis slide, whereas Komatsu relates to a liquid spotting method and a liquid spotting device. In particular, Komatsu teaches a liquid spotting method and a liquid spotting device in which a liquid in a disposable spotting tip is continuously spotted onto a member in a constant amount. If one skilled in the art would have needed to improve the quality of spotting onto a member, he would have turned to Komatsu. That is, one of ordinary skill in the art looking at the references as a whole would have, if at all motivated to combine these references, combined Komatsu's liquid spotting device with Smith's system. Moreover, Komatsu does not teach an incubator in which first and second chemical elements are placed, but rather briefly mentions in passing an incubator used for colorimetric analysis only. (col. 8, lines 4-16).

Smith relates to an apparatus for processing an analysis slide. In particular, Smith teaches an apparatus for processing both rate and endpoint analysis. In passing, Smith mentions a metering device 18, which is adopted to meter sample fluid from one of the plurality of cups 19 in a sample tray 20 onto an analysis slide in a slide distributor 30. (col. 3, lines 40-45). This metering device 18 performs the same functions in substantially different ways than does Komatsu's spotting device. Smith focuses on the capability of handling two types of analysis, whereas Komatsu focuses on the spotting device. One skilled in the art would have no motivation to combine Smith and Komatsu. Therefore, there is no motivation to combine the two references in the manner suggested by the Examiner.

Second, with regard to claims 1, 9 and 16, the references fail to establish *prima facie* obviousness in that they fail to teach or suggest every element as set forth in Applicants' claims. Applicants believe independent claims 1, 9 and 16 would not have been obvious over Smith in view of Komatsu and Quenin. For example, claims 1, 9 and 16 recite an incubator, which stores the first chemical analysis element *and* the second chemical analysis element. An exemplary, non-limiting embodiment of this specific feature is discussed in the specification at page 21, lines 9-19. Also, claims 1, 9 and 16 recite a temperature control means that holds the first *and* second chemical analysis element at a predetermined different temperature. An exemplary, non-limiting embodiment of this specific feature is discussed in the specification at page 21, lines 10-17.

The Examiner does not distinctly and particularly point out the teachings of the recited limitation of an incubator, which stores the first chemical analysis element *and* the second chemical analysis element. Moreover, Smith has two incubators 22 and 24. Incubator 22 stores potentiometric-type slides and incubator 24 stores colorimetric slides. (col. 3, lines 46-49). Therefore, Smith does not teach a single incubator as disclosed in claims 1, 9 and 16. Komatsu teaches an improved spotting device and in passing discloses a colorimetric analysis only. (col. 7, lines 62-67; col. 8, lines 1-16). For example, in Komatsu, a light measuring system 16 is located below the incubator 12, which shows that the Komatsu incubator is used to hold colorimetric slides. (col. 7, lines 60-62). Further, Komatsu does not mention an incubator containing types of slides for measuring ionic activity within a sample liquid. Therefore, Komatsu's incubator stores analysis films 1, which may contain sample liquid and/or reference

liquid for colorimetric analysis only. As a result, Komatsu also fails to teach an incubator which stores the first chemical analysis element *and* the second chemical analysis element.

Third, the Examiner notes that Smith fails to teach a single incubator for maintaining a constant temperature for the analytical slides, wherein the incubator may simultaneously maintain different temperatures for different slides. (Office Action, page 3). The Examiner then contends that Komatsu's incubator 12 is the incubator of the present invention. Although the Examiner asserts that "different temperatures may be maintained," there is no teaching that they are. In fact, Komatsu teaches exactly the opposite. Thus, the Examiner is misinterpreting and/or misapplying the teachings of the reference. In Komatsu, the incubator 12 holds a specific constant temperature. Komatsu teaches: "an incubator 12 which is disposed beside the film supplier 11 and incubates the frameless **chemical analysis films 1** spotted with sample liquids for a predetermined time **at a constant temperature.**" (see col. 7, lines 51-54). Note that "temperature" is singular. Thus, Komatsu's incubator 12 is capable of maintaining only one temperature for all the analysis films: it does not maintain different temperatures for different films. In contrast, the present invention's incubator is capable of holding different temperatures at the same time. Therefore, Komatsu's reference fails to teach or suggest the incubator claimed by Applicant. Similarly, Quenin relates to an analysis positioning apparatus and fails to satisfy the limitation of an incubator as claimed by Applicant.

Finally, the Examiner notes that Smith fails to teach a detection of the position of the analysis slides by way of the bar code reader on the slides. (Office Action, page 3). The Examiner then contends that Quenin's bar code reader meets the bar code reader of the present invention. But the Examiner is misinterpreting and/or misapplying the teachings of the

reference. Quenin only states that “*The kind of slide* that is being supplied to the fluid dispensing station is best determined by a bar code reader (not shown) that reads bar code labels on the slides as they move towards the fluid dispensing station, as is well known in the art.” (col. 4, lines 32-36). Quenin teaches the bar code reader that determines “the kind of slides,” whereas in the present invention, the bar code reader not only determines the types or kinds of slides, but also is used “for detecting the position of the chemical analysis element.” Therefore, Quenin fails to teach or suggest the improved bar code reader with detecting capabilities as claimed by Applicant.

Thus, all three references, Smith, Komatsu and Quenin, fail to teach or suggest a number of elements of the present invention. As a result, Applicant respectfully submits that claims 1, 9 and 16 are patentable over Smith in view of Komatsu and Quenin. Applicant therefore respectfully requests the Examiner to withdraw this rejection of independent claims 1, 9 and 16.

B. Claims 2, 4 and 10-15

Since claims 2, 4 and 10-15 are dependent upon claim 1, Applicant respectfully submits that they are patentable at least by virtue of their dependency.

C. Independent Claim 5

Applicant respectfully traverses this rejection with respect to independent claim 5. The limitations recited in claim 5 are similar to the limitations of holding chemicals at a plurality of temperatures and a bar code reader that detects the position of the slide recited in claim 1. Also, there is no motivation for combining Smith and Komatsu. Please see the above comments in conjunction with claim 1, pages 2-6. Since claim 5 contains features that are similar to the

features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For substantially the same reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 5.

D. Claims 6, 8 and 17-20

Claims 6 and 8 are patentable at least by virtue of their dependency on claim 5. In addition, claims 17-20 are patentable at least by virtue of their dependency on claim 16.

II. Rejections of Dependent Claims

Examiner failed to indicate specific reasons for rejecting dependent claims 19-20. Nonetheless, these claims should be allowable at least by virtue of their dependency on claim 16.

III. Conclusion

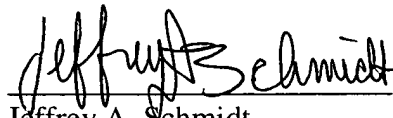
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Response Under 37 C.F.R. § 1.116
US Appln. 09/236,897
Atty. Docket: Q53086

EXPEDITED PROCEDURE

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey A. Schmidt", written over a horizontal line.

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